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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,803

09/29/2003

Robert Zelle

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12/21/2006

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EXAMINER

GRAFFEO, MICHEL

ART UNIT

PAPER NUMBER

1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

12/21/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/674,803	ZELLE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michel Graffeo	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, drawn to a method of modulating a human N-type calcium channel modulating compound, classified in class 415, subclass 183.
- II. Claims 20-22, drawn to a method of making a human N-type calcium channel modulating compound, classified in class 514, subclass 210.01.
- III. Claim 23, drawn to a storage medium comprising chemical structure information, classified in class 514, subclass 211.01.
- IV. Claim 24, drawn to a method of evaluation information, classified in class 514, subclass 228.8.

Inventions I and II are directed to related invention. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a different design, mode of operation, function and effect. In particular, Group I is directed to a method of using a compound to modulate activity whereas Group II is directed to a method of making a compound (not using a compound in a biological system). Furthermore, the inventions as claimed do not encompass

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overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions I and III are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the storage medium cannot be used in a method of modulating a calcium channel.

Inventions I and IV are directed to related inventions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are directed to a method of evaluation and a method of modulation. These two methods have different outcome, different effects and different modes of operation. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions II and III are directed to an unrelated product and process. Product and process inventions are unrelated if it can be shown that the product cannot be used

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in, or made by, the process. See MPEP § 802.01 and § 806.06. In the instant case, the storage medium cannot be used in a method of making a calcium channel.

Inventions II and IV are directed to related inventions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are directed to a method of making a compound and a method of evaluating information. These two methods have different outcome, different effects and different modes of operation. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the storage medium can be used in a system for reference and not evaluation of information.

***Markush Restriction***

The practice, re: Markush claims encompassing multiple independent and patentably distinct inventions is set forth in M.P.E.P. 803. The following requirement to make a provisional election of a single independent and patentably distinct invention is made pursuant to said practice.

Claims 1-19 are drawn in Markush format encompass multiple and patentably distinct inventions. It is pointed out that the claim encompasses in terms of the final species/compound/composition:

Specie 1: the compound of formula (I)

Specie 2: the compound of formula (II)

Specie 3: the compound of formula (III)

Specie 4: the compound of formula (IV)

Specie 5: the compound of formula (V)

Specie 6: the compound of formula (VI)

Specie 7: the compound of formula (VII)

Specie 8: the compound of formula (VIII)

Specie 9: the compound of formula (IX)

Specie 10: the compound of formula (X)

Claims 20-24 are drawn in Markush format encompass multiple and patentably distinct inventions. It is pointed out that the claim encompasses in terms of the final species/compound/composition:

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Specie 1: the compound of formula (I)

Specie 2: the compound of formula (II)

Specie 3: the compound of formula (III)

The groups above are set forth in order of precedence in the claims. Any specie/compound/composition having the distinguishing feature set forth in one of the above groups will be contained in that group regardless of the fact that it may also contain a feature set forth in a group of lower precedence.

It is considered that a Markush type claim encompassing such species is directed to multiple independent and patentably distinct inventions since the species are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the species will not render the claim anticipated or obvious under 35 U.S.C. 102 nor 35 U.S.C. 103 respectively with regard to any one other of the species. Further these species are considered to be independent since they are unconnected in operation, one does not require the others for ultimate use and the specification does not disclose a dependent relationship between them. Moreover, each of the stated species is considered patentably distinct from the others on the basis of its properties. Thus, the stated species are capable of supporting separate patents under 35 U.S.C. 121.

Accordingly, applicants are required to make a provisional election of a single independent and /or patentably distinct species stated *supra* prior to an examination of said species on the merits. This election will be given effect in the event the Markush

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type claims are not found allowable, at which time the examination of the claims presented will be limited to the Markush type claims and claims directed solely to the elected species. The claims directed solely to the nonelected species will be held withdrawn from further consideration. It should be noted that an election of species has been held to be tantamount to a requirement for restriction (see *In re Herrick*, 1958 CD 1, and *In re Joyce* 1958 CD2).

Applicant's response must include a provisional election of one of the independent and patentably distinct inventions identified above even though the requirement is traversed (37 C.F.R. 1.142 and 1.143). Applicant is advised that any traverse must be supported by argument in order to perfect the right to petition in the event that the provisional requirement is given effect in the event noted above.

A shortened statutory period for response to this action is set to expire 30 days from the date of this letter.

### ***Rejoinder Notice***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.



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In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Election***

This application contains claims directed to more than one species of the generic invention.

The following specie election is required also regarding the election of either of Groups I-IV and the additional election of Species 1-10, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically,

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applicant is required to define each of  $R^1$ ,  $R^2$ ,  $R^3$ ,  $R^4$ ,  $R^5$ ,  $R^6$ , Ar, Cy, V, W, X, Y, n and m and any additional variables as required for a particular species. Currently, claims 1, 20-24 are generic.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

### ***Election/Restrictions Proper***

MPEP §809.02(d) states "[w]here only generic claims are presented, no restriction can be required except in those applications where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is

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necessary.”. Here, the claims recited such a multiplicity of species that an unduly extensive and burdensome search would be necessary if all of the claimed species were to be examined simultaneously.

The present claims are directed to a method of treating respiratory complaints. Present claim 1 for example provides a variety of possibilities for  $R^1$ ,  $R^2$ ,  $R^3$ ,  $R^4$ ,  $R^5$ ,  $R^6$ , Ar, Cy, V, W, X, Y, n and m. For hypothetical exemplification purposes only, if each of the variables above were each limited to 10 possible moieties there would be  $10^{14}$  possible species of compounds to be searched.

Further, as shown by the following classifications, a majority of the combinations encompassed by the present claims has acquired a separate status in the art. For example, if Y is a 7 membered ring containing one N it is classified in class 514 subclass 212.01 whereas if Y is a 6 membered ring containing one N it is classified in class 514 subclass 222.2. Notwithstanding that the classification of some of the active agents is co-extensive, all of the claimed compounds are patently distinct and fully capable of supporting separate patents.

The inventions above are patentably distinct. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Burden consists not only of specific searching of classes and subclasses, but also of searching multiple databases for foreign references and literature searches. Burden also resides in the examination of independent claim sets for clarity, enablement, and double patenting issues. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the

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consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application and the restriction for examination purposes as indicated above is deemed proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

#### ***Inventorship Notice***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michel Graffeo whose telephone number is 571-272-8505. The examiner can normally be reached on 9am to 5:30pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

13 December 2006

MG

*Ardin H. Marschel 12/18/06*  
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SUPERVISORY PATENT EXAMINER